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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,299	04/15/2004	Fernando Campbell Boyd III	CB1	5960

7590 06/29/2005

Jason L. Hornkohl  
3712 Woodmont Lane  
Nashville, TN 37215

EXAMINER

KRAWCZEWICZ MYERS, LOUANNE C

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/824,299

Applicant(s)

BOYD ET AL

Examiner

Louanne C. Krawczewicz Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

LK Myers

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## **DETAILED ACTION**

### Objection to the Disclosure

#### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

#### **35 USC 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112 first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

- A. The disclosure is objected to under 37 CFR 1.121 (e) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c) (4)(5) and 37 CFR 1.163(d). This information should be set forth before the "BACKGROUND OF THE INVENTION" section as set forth in 37 CFR 1.163(c) and after the "Inventors" section, page 1, line 5.
- B. The specification is objected to under 37 CFR 1.163(d) because the text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type. Correction to the specification is necessary.

- C. Page 1, lines 7,8,10-12, and 20; page 2, lines 1, 6, 7, 11,12, and 17; page 3, lines 4,5, and 7; page 4, lines 3,8,11,12,13,15,18 and 20; page 5, line 2; page 6, line 6; page 8, line 6; and page 10, line 2, "*Magnolia virginiana* var. *australis*" and "*Magnolia virginiana*" should be either italicized or underlined as this is the proper way to set forth a Genus/species.
- D. Page 1, line 12, and 14-16; page 3, lines 16 and 17; page 5, lines 12,18 and 21, Applicants state "Sleepy Hollow Nursery" and "Boyd Nursery". These recitations constitute unwarranted advertising and should be deleted from the specification (MPEP 1610). Applicants should review the specification for similar occurrences and correct the specification accordingly.
- E. Page 1, line 11, Applicants state the instant tree was discovered within "a group of *Magnolia virginiana* var. *australis* seedlings". However, Applicants have not stated where the seedlings came from. The origin of the instant tree is not clear. Applicants should set forth in the specification detail regarding the origin of the instant tree. The origin of the instant tree should be clearly and unambiguously set forth in the specification. In addition, Applicants state the new tree is a "dwarf variant of the *Magnolia virginiana* var. *australis*" on page 4, lines 12 and 13. This would lead one to believe the instant tree is a mutation of a specific tree. Further, Applicants state "Unnamed *Magnolia virginiana* var. *australis*" on page 6,

line 6. This recitation causes more confusion regarding the instant tree's origin. Correction to the specification and/or clarification is necessary.

F. Page 1, line 20, Applicants state "normal". This recitation is unclear as it is not understood what Applicants intend "normal" to mean. Correction to the specification and/or clarification is necessary.

G. Page 2, lines 6,11, and 16; page 3, line 7; page 4, lines 3,15,17,19, and 20; and page 5, line 1, Applicants state "typical". This recitation is unclear as it is not understood what Applicants intend "typical" to mean. Correction to the specification and/or clarification is necessary.

H. If the instant tree was produced from a crossing of two trees or a mutation of a specific tree, Applicants should set forth in the specification the name of the parental plant (for both seed and pollen parents) or if unnamed, state "an unnamed plant". Applicants should also set forth the genus/species of the parental plant.

I. If the instant tree was produced from a crossing of two trees or a mutation of a specific tree, Applicants are requested to set forth in the specification whether the

parental cultivar(s) has been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name.

J. If the instant tree was produced from a crossing of two trees or a mutation of a specific tree, Applicants are requested to import into the specification a brief comparison between the instant plant and the parental cultivar(s), such need not be in any great detail, but should at least be to the extent necessary to positively distinguish the respective plants from each other.

K. Page 3, lines 3 and 10; page 5, lines 5,6,11, and 20; and page 6, line 19, Applicants state "parent plant". This recitation is unclear as it is not understood what parent plant Applicants intend as no parent tree has been set forth. It appears Applicants may have meant to state --originally discovered tree--.

Correction to the specification and/or clarification is necessary.

- L. Page 4, line 8, Applicants state "specimen". Rather than stating specimen, it appears the term --tree-- would be more appropriate to use in this instance.
- M. Page 5, lines 17 and 18, Applicants state that the "fourth photographic drawing shows a number of second generation 'Sweet Thing' rooted cuttings". However, on page 2, lines 18 and 19, Applicants state that the fourth photographic drawing shows the instant plant's flower. These recitations are contradictory and it is unclear which drawing is the fourth photographic drawing since the drawings have not been numbered. Correction to the specification and/or clarification is necessary.
- N. Page 6, line 6, Applicants state "Unnamed *Magnolia virginiana* var. *australis*". It appears that --Unnamed plant of *Magnolia virginiana* var. *australis* -- would instead be more botanically accurate.
- O. Page 6, lines 16-23, page 7 and page 8, Applicants have changed to single spacing format. The proper format of the specification should instead be double spacing. Correction to the specification and/or clarification is necessary.
- P. Page 6, lines 18 and 19, Applicants set forth the instant plant's young stem color, however, the instant plant's mature stem is not set forth. Applicants should set



forth in the specification additional information relative to the instant plant's young and mature stem and branches including typical and observed length, diameter, internode length, texture, and mature stem and branch coloration with reference to the employed color chart.

Q. Page 6, line 18, Applicants state "144 A-C RHS". It is unclear what Applicants intend by the recitation "A-C" and whether both colors are present or whether a mixture of the two colors are present or whether the instant young stem color is a color in between. Correction to the specification and/or clarification is necessary.

R. Page 7, line 1, Applicants have set forth the instant plant's petiole length, however, Applicants should set forth in the specification additional information relative to the instant plant's petioles including diameter and coloration with reference to the employed color chart.

S. Page 7, lines 1 and 2, Applicants should set forth in the specification additional information relative to the instant plant's leaves including the typical and observed leaf apex and base descriptor.

- T. Page 7, line 3, Applicants state "*Width- 2.85 cm to 4.52 cm.*". It is unclear what Applicants are referring to with respect to the instant plant. Correction to the specification and/or clarification is necessary.
- U. Page 7, lines 4-10, it is unclear if Applicants are referring to the instant plant's leaves or something else. Correction to the specification and/or clarification is necessary.
- V. Page 7, line 10, Applicants state that the instant plant's vein color is "(151 A RHS)". It is unclear if this vein color is for upper, lower or both surfaces. Applicants should set forth in the specification the instant plant's vein color for both surfaces with reference to the employed color chart, if readily available.
- W. Page 7, line 20, Applicants set forth that the instant plant's flower is "10 to 12 cm across". Applicants should also set forth in the specification additional information relative to flower size including the typical and observed flower depth (height).
- X. Page 7, lines 22 and 23, Applicants state "Petals". It appears --Tepals-- may be more botanically accurate to use in this instance. Applicants should also set forth additional information in the specification relative to the instant plant's tepal

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texture, both surfaces. Correction to the specification and/or clarification is necessary.

Y. Applicants should set forth in the specification information relative to the instant plant's peduncles including the typical and observed length, diameter and coloration with reference to the employed color chart.

Z. Page 7, line 26, Applicants set forth flower blooming duration, however, it is not certain whether the flower longevity is for the flowers on or off the plant. Applicants should set forth in the specification flower longevity on and off the plant.

AA. Page 7, line 27, Applicants set forth in the specification that the instant plant's stamen color is "brown". Applicants should set forth in the specification the instant plant's stamen color with reference to the employed color chart, if readily available.

BB. Page 8, line 1, Applicants set forth in the specification that the instant plant's pollen color is "yellow". Applicants should set forth in the specification the instant plant's pollen color with reference to the employed color chart, if readily available.

- CC. Applicants should set forth in the specification additional information relative to the instant plant's reproductive organs including pistil number, anther, stigma, styles, ovary/ies, (such as quantity, size and coloration of the organs) into the specification with reference to the color chart employed (if available).
- DD. Page 8, line 2, Applicants set forth in the specification that the instant plant's fruit color is "light green to brown". Applicants should set forth in the specification the instant plant's fruit color with reference to the employed color chart, if readily available.
- EE. Page 8, line 2, Applicants should set forth in the specification additional information relative to the size of the instant plant's conelike aggregate of follicles including length and diameter.
- FF. Page 8, lines 3 and 4, Applicants should set forth in the specification additional information relative to the instant plant's seeds such as the typical and observed number of seeds per conelike aggregates of follicle, shape, length, and diameter, if readily available.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

#### Claim Rejection

#### 35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> Paragraphs

**Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.**

**Comments**

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance.

Applicant should specifically authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

Applicant should note the new amendment format. (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

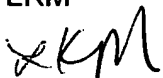
**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louanne C. Krawczewicz Myers whose telephone number is (571) 272-0979. The examiner can normally be reached on Monday and Thursday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone numbers for the group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent electronic business center whose telephone number is (866)-217-9197 (toll free) or (703) 305-3028 or (703) 308-6845 or email requests to [ebc@uspto.gov](mailto:ebc@uspto.gov).

LKM



**KENT BELL  
PRIMARY EXAMINER**

